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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MOE, A

ART UNIT

PAPER NUMBER

2612

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/666,653

Applicant(s)
Honda et al.

Examiner
Aung S. Moe

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2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 27, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 19-26 and 31-42 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☒ Claim(s) 19-26 is/are allowed.

6) ☒ Claim(s) 31-42 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on April 27, 2001 have been fully considered but they are not persuasive.

Regarding claim 31-32, 34-36, and 38, the Applicant alleged (in page 10 of the remarks) that nothing in Inoue '954 shows, teaches or suggests "a) a reproduction mode in which a still picture is reproduced out of a picture recorded as a moving picture on a recording medium or b) a mode selector for selecting among a plurality of shooting and reproducing modes".

In response, the Examiner disagrees because Inoue '954 does in fact shows the above mentioned claimed limitations. For example, as shown in the figures' 17, 19 and 20, the images stored (i.e., recorded) within the image memory 111 is reproduced in the LCD monitor when the camera is in a reproduction mode. In particular, it is cleared from Figs. 19/20 that the still picture reproduced on the LCD monitor (112) is the still picture stored (i.e., recorded) as the moving picture on the recording medium (111). Furthermore, It is also noted that the recording medium (111) is capable of recording (i.e., storing) the still image or a moving image therein (see col. 22, lines 4+ of Inoue '954). In particular, Inoue '954 suggested at col. 22, lines 5+ that when the 1st release signal is output by half depressing the release button, the still picture recorded (i.e., stored) as the moving picture on the recording (111) is reproduced on the LCD display (112) and this allowed the photographer to confirm a preceding-frame screen using a submonitor display at

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any time. Therefore, it is cleared that during the reproducing mode the moving picture recorded (i.e., stored) on the recording medium (111) may be reproduced as a still picture when the photographer depressed the release button thereof.

Moreover, as previously stated by the Examiner Inoue '954 does in fact show the mode selector for selecting among a plurality of shooting and reproducing modes. In this case, it is noted that with the use of control unit 30, 123 or 237 and the input units, the user is not prevented to select among a plurality of shooting (i.e., Film, Still or Motion shooting modes) and reproducing modes (i.e., Still/Motion reproducing modes; see the Abstract) as shown in the invention of Inoue '954. The Applicant's attention is further directed to Figs. 2, 5-8, 16, 18 and 21-22 of Inoue '954.

In view of the above, Claims 31-32, 34-36, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (U.S. 5,710,954) as follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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3. Claims 31-32, 34-36, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (U.S. 5,710,954).

Regarding claim 31, Inoue '954 discloses a photographing apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

a first recording section (*i.e., noted the use of a silver salt film*) for recording, on a first recording medium, mainly still pictures together with information relating to the still pictures thus recorded (*as shown in Figs. 4 and 9, it is noted that with the use of the magnetic recording circuit 13, the information relating to the still pictures recorded on the film may be recorded on a magnetic recording layer 51 of the film so that such information may be used when a still picture recorded on the film is printed; see col. 9, lines 30+ and col. 11, lines 40+*);

a second recording (*i.e., noted the use of Memory 111, 125 or 226*) section capable of recording, on a second recording medium, moving pictures and also pictures to be reproduced as still pictures; and

a mode selector for selecting among a plurality of shooting and reproducing modes (*i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium (*see Figs. 2 & 5, col. 11, lines 15+ and col. 26, lines 39+*), a mode in which a moving picture is recorded on the second recording medium, and a mode in which a picture to be reproduced as a still picture is recorded on the second recording medium

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(i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+), said reproducing modes including a mode in which information relating to a still picture recorded on the first recording medium is displayed (Figs. 7-9, col. 3, lines 4+, col. 12, lines 10+ and col. 13, lines 15+), a mode in which a moving picture recorded on the second recording medium is reproduced (col. 21, lines 25+), a mode in which a picture recorded on the second recording medium so as to be reproduced as a still picture is reproduced (Fig. 15, col 21, lines 25-68), and a mode in which a still picture (i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor) is reproduced out of a picture recorded as a moving picture (i.e., Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor) the second recording medium (i.e., the memory device as shown in Figs. 12 & 17).

Regarding claim 35, Inoue '954 discloses a photographing apparatus *see Figs. 1, 12, 17 and 25)* comprising:

a first recording section for recording *(i.e., noted the use of a silver salt film)*, on a first recording medium, mainly still pictures together with information relating to the still pictures thus recorded *(as shown in Figs. 4 and 9, it is noted that with the use of the magnetic recording circuit 13, the information relating to the still pictures recorded on the film may be recorded on*

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a magnetic recording layer 51 of the film so that such information may be used when a still picture recorded on the film is printed; see col. 9, lines 30+ and col. 11, lines 40+);

a second recording section capable of recording (i.e., noted the use of Memory 111, 125 or 226), on a second recording medium, moving pictures and still pictures; and

a mode selector for selecting among a plurality of shooting and reproducing modes (i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16), said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium (see Figs. 2 & 5, col. 11, lines 15+ and col. 26, lines 39+), a mode in which a moving picture is recorded on the second recording medium, and a mode in which a still picture recorded on the second recording medium (i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+), said reproducing modes including a mode in which information relating to a still picture recorded on the first recording medium is displayed (Figs. 7-9, col. 3, lines 4+, col. 12, lines 10+ and col. 13, lines 15+), a mode in which a moving picture recorded on the second recording medium is reproduced (col. 21, lines 25+), a mode in which a still picture recorded on the second recording medium is reproduced (Fig. 15, col 21, lines 25-68), and a mode in which a still picture (i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the

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sub-monitor) is reproduced out of a picture recorded as a moving picture (*i.e.*, *Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) the second recording medium (*i.e.*, *the memory device as shown in Figs. 12 & 17*).

Regarding claims 32 and 36, Inoue '954 discloses wherein the information recorded on the first recording medium is information used when a still picture recorded on the first recording medium is printed (*col. 11, lines 30+ and col. 12, lines 5+ of Inoue '954*).

Regarding claims 34 and 38, Inoue '954 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes (*see Figs. 6-7, col. 3, lines 4+, col. 9, lines 7+, col. 12, lines 10+ of Inoue '954*).

4. Applicant's arguments with respect to claims 33, 37, 39-40 and 41-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

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commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Ootsuka (U.S. 5,774,754).

As for claims 33 and 37, Inoue '954 discloses that an aspect ratio of the picture can be varied for the still images with the use of the post-processing information input unit 27 (*Figs. 6-7, col. 12, lines 5+ of Inoue '954*), however, Inoue '954 does not explicitly shows wherein an aspect ratio of the moving picture can be varied as recited in claim 33 and 37.

Nevertheless, the above mentioned claimed limitations are well known in the art as evidenced by Ootsuka '754. In particular, Ootsuka '754 teaches that it is well-known to vary an aspect ratio of the recorded moving picture, for example, with the use of control dial 33/34 and the element 62, the user is capable of varying the aspect ratio of the picture in any of the modes (i.e., the shooting/recording and reproducing modes) in which a moving picture is recorded (*see col. 6, lines 15+, col. 7, lines 54+, col. 9, lines 10+, col. 11, lines 5+ and col. 23, lines 35+; Figs. 14-17, 32 and 45*), and this would allow the operator to confirm or check how a reproduced image looks after concerning a photographing operation is changed, so that a desired picture can always be obtained (*see col. 1, lines 40+*).

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In view of the above, having the system of Inoue '954 and then given the well-established teaching of Ootsuka '754, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the system of Inoue '954 by providing the aspect ratio selector for varying an aspect ratio of a picture in any of the camera's operation modes in which a moving picture is recorded as taught by Ootsuka '754, since Ootsuka '754 suggests at col. 1, lines 40+ that such a modification would allow the operator to confirm or check how a reproduced image looks after concerning a photographing operation is changed, so that a desired picture can always be obtained.

7. Claims 39-40 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Ootsuka (U.S. 5,774,754).

Regarding claim 39, Inoue '954 discloses a photographic apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

a recording section capable of recording, on a recording medium (*i.e., noted the use of Memory 111, 125 or 226*), moving pictures and also pictures to be reproduced as still pictures (col. 19, lines 30+ and col. 21, lines 55+);

a mode selector for selecting among a plurality of shooting and a reproducing modes (*i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select*

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among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16), said shooting modes including a mode in which a moving picture is recorded on the recording medium and a mode in which a picture to be reproduced as a still picture is recorded on the recording medium (i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+), said reproducing modes include a mode in which the moving picture recorded on the recording medium is reproduced (col. 21, lines 25+), a mode in which a picture recorded on the recording medium so as to be reproduced as the still picture is reproduced (Fig. 15, col 21, lines 25-68), and a mode in which a still picture (i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor) is reproduced out of a picture recorded as a moving picture (i.e., Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor) on the recording medium (i.e., the memory device as shown in Figs. 12 & 17); and

Regarding claim 41, Inoue '954 discloses a photographic apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

a recording section capable of recording, on a recording medium (*i.e., noted the use of Memory 111, 125 or 226*), moving pictures and still pictures (col. 19, lines 30+ and col. 21, lines 55+);

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a mode selector for selecting among a plurality of shooting and a reproducing modes (*i.e.*, *noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a moving picture is recorded on the recording medium and a mode in which a still picture is recorded on the recording medium (*i.e.*, *noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+*), said reproducing modes include a mode in which a moving picture recorded on the recording medium is reproduced (*col. 21, lines 25+*), a mode in which a still picture recorded on the recording medium is reproduced (*Fig. 15, col 21, lines 25-68*), and a mode in which a still picture (*i.e.*, *Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor*) is reproduced out of a picture recorded as a moving picture (*i.e.*, *Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) on the recording medium (*i.e.*, *the memory device as shown in Figs. 12 & 17*).

Furthermore, it noted that although Inoue '954 discloses that an aspect ratio of the picture can be varied for the still images with the use of the post-processing information input unit 27 (*Figs. 6-7, col. 12, lines 5+ of Inoue '954*), Inoue '954 does not explicitly shows wherein an aspect ratio of the moving picture can be varied as recited in claim 39 and 41.

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Nevertheless, the above mentioned claimed limitations are well known in the art as evidenced by Ootsuka '754. In particular, Ootsuka '754 teaches that it is well-known to vary an aspect ratio of the recorded moving picture, for example, with the use of control dial 33/34 and the element 62, the user is capable of varying the aspect ratio of the picture in any of the modes (i.e., the shooting/recording and reproducing modes) in which a moving picture is recorded (*see col. 6, lines 15+, col. 7, lines 54+, col. 9, lines 10+, col. 11, lines 5+ and col. 23, lines 35+; Figs. 14-17, 32 and 45*), and this would allow the operator to confirm or check how a reproduced image looks after concerning a photographing operation is changed, so that a desired picture can always be obtained (*see col. 1, lines 40+*).

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Ootsuka '754, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the system of Inoue '954 by providing the aspect ratio selector for varying an aspect ratio of a picture in any of the camera's operation modes in which a moving picture is recorded as taught by Ootsuka '754, since Ootsuka '754 suggests at col. 1, lines 40+ that such a modification would allow the operator to confirm or check how a reproduced image looks after concerning a photographing operation is changed, so that a desired picture can always be obtained.

Regarding claims 40 and 42, Inoue '954 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes (*see Figs. 6-7, col. 3, lines 4+, col. 9, lines 7+, col. 12, lines 10+ of Inoue '954*).

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Allowable Subject Matter

8. Claims 19-26 are allowed for the reasons set forth in the previous Office action (please see paper no. 7 & 12).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is (703) 306-3021. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

A. Moe

July 9, 2001


AUNG S. MOE
PATENT EXAMINER